REMARKS

Claims 1-61 are currently pending. Claims 25 and 53 and paragraph 78 have been amended to correct a typographical error. Claim 34 has been cancelled. Paragraphs 51, 61, 68, 81, and 87 have been amended to capitalize the trademarks appearing therein, and paragraphs 51 and 68 have been amended to list corresponding generic terminology for the trademarks, as requested by the Office. No new matter has been added by these amendments.

1. Objection to the Claims

The Office has objected to claim 25, stating that the term "antiviral" is misspelled. Claims 25 and 53 and ¶78 have been amended to change "antivirul" to "antiviral".

2. Specification

The Office has noted the use of the trademark "Dow Corning©" in the application, stating that the trademark sould be capatilized wherever it appears and accompanied by generic terminology. Paragraphs 51, 61, 68, 81, and 87 have been amended to capatilize the trademark "DOW CORNING", and paragraphs 51 and 68 have been amended to add generic terminology as requested by the Office. In support of the amendments to paragraphs 51 and 68, applicants submit herewith copies of product information for DOW CORNING 200, DOW CORNING 1503, and DOW CORMING 5329, which provide a generic description of the product covered by these trademarks.

3. Rejection of the Claims under 35 U.S.C. §112, first paragraph

Reconsideration is requested of the rejection of claims 24 and 57 under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. In particular, the Office has stated that the specification does not teach how to use glucosylceramide (citing no amounts, weights or percentages given, and no discussion as to how it is incorporated into the tissue product claimed[1]).

MPEP 2163 states that "[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." Furthermore, with regard to originally filed claims, it is well accepted that "a satisfactory description may be in the claims or any other portion of the originally filed specification."[2]

---

[1] Applicants assume the Office meant to refer to an absorbent product, since the claims of the present application are directed to absorbent products, not tissue products.

[2] MPEP §2163. *See also id.*, citing In re Koller, 613 F.2d 819 (CCPA 1980) (original claims constitute their own description); MPEP 2163.06 ("The claims as filed in the original specification are part of the disclosure."); MPEP §608.01(l) ("In establishing a disclosure, applicant may rely not only on the description and drawings as filed but also on the original claims if their content justifies it. Where subject matter not shown in the drawings or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim.").

Applicants note that glucosylceramide is set forth in claims 24 and 57 as originally filed. For instance, original claim 24 reads: "The absorbent product as set forth in claim 23 wherein the ceramide is glucosylceramide."[3] Written description support for glucosylceramide may therefore be found in original claims 24 and 57.

With regard to the Office's comments regarding amounts, weights, percentages, and method for incorporating glucosylceramide into the absorbent product, applicants respectfully note that in order to satisfy written description, the claimed invention must be described in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. In the present case, possession is clearly shown by the disclosure of glucosylceramide in original claims 24 and 57. Applicants are not required to show how to make or use absorbent products comprising glucosylceramide to satisfy the written description requirement.

4. Rejection of the Claims under 35 U.S.C. §103(a)

Reconsideration is requested of the rejection of claims 1-23, 25-33, 35-56, and 58-61 under 35 U.S.C. §103(a) as being unpatentable over Vega, et al. (U.S. Patent No. 6,153,209).

Claim 1 is directed to an absorbent product comprising an absorbent substrate and a moisturizing and lubrication composition. The moisturizing and lubricating composition

[3] Original claim 57 is similar, reading "The absorbent product as set forth in claim 56 wherein the ceramide is glucosylceramide."

comprises from about 1% (by weight) to about 40% (by weight) of an emollient, from about 1% (by weight) to about 20% (by weight) of a humectant, from about 30% (by weight) to about 90% (by weight) an immobilizing agent, and from about 1% (by weight) to about 40% (by weight) of a compatibilizing agent wherein no more than about 50% (by weight) of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature, and wherein at least about 85% (by weight) of the components of the moisturizing and lubricating composition form a single phase at a temperature of from about 45°C to about 80°C.

Vega, et al. is directed to absorbent articles having a skin care composition deposited on at least a portion of the article. The skin care composition is a breathable, barrier protectant which can be immobilized on the article and is transferable to the wearer's skin via contact, normal wearer motion, and/or body heat. The skin care composition may comprise an emollient in an amount of from about 5 to about 95 wt.% of the skin care composition; an immobilizing agent in an amount of from about 5 to about 95 wt.% of the skin care composition, and optionally a humectant. Vega, et al. state that the compositions preferably fully melt at a temperature significantly above room temperature, and typically are applied to the article by heating the composition to a temperature in the range from about 35°C to about 150°C prior to application. Vega, et al. also state that the compositions preferably have a melt profile wherein 2-50% of the composition is liquid at room temperature (20°C).

In order for the Office to show a prima facie case of obviousness, M.P.E.P. §2143 requires that the Office must meet three criteria: (1) the prior art reference must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, and (3) there must be some reasonable expectation of success. The Office has clearly failed to meet its burden under number (1) and/or (2) above, as the cited reference does not teach or suggest all of the claimed limitations and there is no motivation or suggestion to modify the reference to arrive at each and every limitation of Applicants' claim 1.

Initially, applicants note that Vega, et al. fail to teach or suggest a composition comprising from about 1% (by weight) to about 40% (by weight) of a compatibilizing agent. The Office has cited column 26, line 5 of Vega, et al. as disclosing compatibilizing agents. As the Office has correctly noted, Vega, et al. do disclose that their compositions may comprise propylene glycol, butylene glycol, and certain low molecular weight polyethylene glycols (e.g., PEG-2, PEG-3, etc.),[4] which may be considered compatibilizing agents.[5] Vega, et al., however, fail to teach or suggest the amounts of these agents that may be present in the compositions described therein, and in particular, fail to teach or suggest compositions comprising

[4] *See* Vega, et al. at col. 26, lines 5-7, and col. 27, lines 48-49.
[5] *See* specification at p. 25, ¶67.

from about 1% (by weight) to about 40% (by weight) of these compounds or of compatibilizing agents generally.

Recognizing this deficiency, the Office has stated with regard to the claimed ranges, that "it would have been obvious to determine suitable percentages through routine or manipulative experimentation to obtain the best possible results, as these are variable parameters attainable within the art." Applicants respectfully disagree.

As noted in the specification of the present invention, the compatibility of the moisturizing and lubricating compositions of the present invention is important for the processability and stability of the compositions. In particular, paragraph 66 of the specification states:

> Incompatible compositions require a more rigorous process to ensure that mixing is complete so as to prevent the separation of the different components in the composition. More mixing requires higher energy consumption, which leads to an increase in the cost of manufacturing the products. Further, it may be very difficult for an incompatible composition to maintain acceptable stability during the life of the product, starting with shipping, transportation, and storage prior to ultimate use by the consumer. Many incompatible ingredients may tend to slowly separate from the surface of the product to which they are applied resulting in a loss of the properties of the overall composition and a potential loss in the intended benefits.

The specification further states that certain components of the moisturizing and lubricating compositions, such as several of the immobilizing agents (e.g., high molecular weight polyethylene glycols), are incompatible with some humectants,

such as glycerin.[6] Thus, in order to ensure a high degree of compatibility, the moisturizing and lubricating compositions include a compatibilizing agent. Compatibilizing agents are thus important for improving processing of the compositions, and to ensure good compatibility and a substantially homogenous composition.

None of these benefits of compatibilizing agents are taught or even recognized by Vega, et al. In particular, Vega, et al. merely list propylene glycol, butylene glycol, and certain polyethylene glycols as suitable humectants for use in their compositions.[7] Alternately, Vega, et al. state that propylene glycol and polyethylene glycols are suitable solvents for preservatives that may be included in the compositions.[8] There is, however, no disclosure of using propylene glycol, butylene glycol, or low molecular weight polyethylene glycols as compatibilizing agents, or of the need for compatibilizing agents generally. Nor do Vega, et al. disclose suitable amounts of propylene glycol, butylene glycol, or low molecular weight polyethylene glycols for inclusion in their compositions. Consequently, why would one skilled in the art be motivated to determine the suitable amount of compatibilizing agent for inclusing in the compositions of Vega, et al. when Vega, et al. fail to disclose or suggest the need for such agents, and the only disclosed uses for propylene glycol, butylene glycol, and polyethylene glycols are as humectants and/or solvents for preservatives? While one skilled in the art may be able to

[6] *See* Specification at p. 25, ¶67.
[7] *See* Vega, et al. at col. 26, lines 3-7.
[8] *See* Vega, et al. at col. 27, lines 48-49.

optimize the amount of humectant to incorporate into the compositions of Vega, et al. based on the disclosure therein, one skilled in the art would not and could not be motivated to determine a suitable amount of compatibilizing agent for inclusion in the compositions of Vega, et al. giving the lack of teaching or recognition of the benefits of doing so.

In light of the foregoing, applicants respectfully submit that claim 1 is patentable over Vega, et al.

Claims 2-23 and 25-31 depend directly or indirectly from claim 1 and are thus patentable for the same reasons as set forth above for claim 1 as well as for the additional elements they require.

Additionally, claim 10 requires the polyethylene glycol to be selected from the group consisting of PEG 1000, PEG 3350, PEG 6000, PEG 8000, and PEG 10,000. Vega, et al. fail to teach or suggest compositions comprising any of these immobilizing agents.

The Office has cited to column 26, lines 6-7 of Vega, et al. as disclosing the polyethylene glycols listed in calim 10. However, as noted above, the PEGs listed in this passage are low molecular weight PEGs that are disclosed as being useful humectants. In particular, Vega, et al. disclose PEG-2, PEG-3, PEG-30, and PEG-50. These are clearly not the same compound as PEG 1000, PEG 3350, PEG 6000, PEG 8000, or PEG 10,000. In fact, nowhere does Vega, et al. even suggest that the compositions disclosed therein should or could include high molecular weight polyethylene glycols, much less any of the specific PEGs listed

in applicants' claim 10. Claim 10 is thus patentable over Vega, et al. for this additional reason.

Independent claim 32 is directed to an absorbent product comprising an absorbent substrate and a moisturizing and lubrication composition comprising from about 1% (by weight) to about 40% (by weight) of a silicone, from about 1% (by weight) to about 20% (by weight) of a humectant, from about 30% (by weight) to about 90% (by weight) an immobilizing agent, from about 1% (by weight) to about 40% (by weight) of a compatibilizing agent and a dispersing agent wherein no more than about 50% (by weight) of the components are liquid at room temperature and no less than about 50% of the components are solid at room temperature, and wherein at least about 85% (by weight) of the components of the moisturizing and lubricating composition form a single phase at a temperature of from about 45°C to about 80°C.

Claim 32 is patentable for the same reasons as set forth above for claim 1. In particular, Vega, et al. fail to teach or suggest a composition comprising from about 1% (by weight) to about 40% (by weight) of a compatibilizing agent. Nor would there be any motivation to modify the compositions of Vega, et al. to arrive at such a composition.

Claims 33 and 35-61 depend directly or indirectly from claim 32 and are therefore patentable for the same reasons as set forth above for claim 32 as well as for the additional elements they require.

Additionally, claim 42 requires the polyethylene glycol to be selected from the group consisting of PEG 1000, PEG 3350, PEG

6000, PEG 8000, and PEG 10,000. Vega, et al. fail to teach or suggest compositions comprising any of these immobilizing agents.

As discussed above, the Office has cited to column 26, lines 6-7 of Vega, et al. as disclosing the polyethylene glycols listed in claim 42. However, the PEGs listed in this passage are low molecular weight PEGs that are disclosed as being useful humectants. In particular, Vega, et al. disclose PEG-2, PEG-3, PEG-30, and PEG-50. These are clearly not the same compound as PEG 1000, PEG 3350, PEG 6000, PEG 8000, or PEG 10,000. In fact, nowhere does Vega, et al. even suggest that the compositions disclosed therein should or could include high molecular weight polyethylene glycols, much less any of the specific PEGs listed in applicants' claim 42. Claim 42 is thus patentable over Vega, et al. for this additional reason.

4. Double Patenting Rejections

Claims 1-61 have been provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of copending Application No. 10/659,862.

Applicants note this rejection is in fact a provisional obviousness-type double patenting rejection since U.S. Patent Application No. 10/659,862 has not yet issued as a patent. Applicants will address the merits of these rejections, as appropriate, if the listed application issues as a patent before the application at hand.

CONCLUSION

In light of the foregoing, applicants request withdrawal of the rejections of claims 1-61 and allowance of all pending claims. The Commissioner is hereby authorized to charge any government fees which may be required to Deposit Account No. 19-1345.

Respectfully Submitted,

/Christopher M. Goff/

Christopher M. Goff, Reg. No. 41,785
SENNIGER POWERS
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
314-231-5400

CMG/LJH/cms
By EFS